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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,818	11/22/1999	STEVEN DEARMOND CURTIN	10	9132

7590 04/07/2004

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EXAMINER
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MIRZA, ADNAN M

ART UNIT	PAPER NUMBER
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2141

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DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/444,818

Applicant(s)

CURTIN, STEVEN DEARMOND

Examiner

Adnan M Mirza

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

Examiner withdraws the finality of the rejection.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1,12,23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As per claim 1,12,23 recited “ the command being entered at a wireless receiver, the identification information being extracted and stored without requiring any connection between the wireless receiver and an access point of a data network” which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackintosh et al (U.S. 6,317,784) and in view of Cluts (U.S. 5,616,876).

As per claims 1, 12 & 23 Mackintosh disclosed a method of providing information to a user, the method comprising the steps of: storing identification information extracted from a current broadcast which is being presented in a perceptible form to a user, in response to a command from the user (col. 6, lines 1-20), the command being entered at a wireless receiver, the identification information being extracted and stored without requiring any connection between the wireless receiver (col. 9, lines 19-33), the identification information being extracted and stored without requiring any connection between the wireless receiver and an access point of a data network (col. 16 lines 41-45), wherein the identification information specifies sufficient information to identify at least one deliverable information item associated with the broadcast (col. 3, lines 1-16);

However Mackintosh failed to disclose subsequently delivering at least a portion of the extracted identification information over the data network to a server which processes the identification information to identify the at least one deliverable information item associated with the broadcast. In the same field of endeavor Cluts disclosed a delivering at least a portion of the extracted information over a network to a server which processes the delivered information to identify the at least one deliverable information item associated with the broadcast (col. 15, lines 14-25 & col. 6, lines 1-10).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a delivery of extracted information over a network to a server and to identify at least one delivered information as taught by cluts in the method Mackintosh to improve the sorting method of the selected music files by the subscriber and also for the subscriber to quickly assess the mix of the music included in a play list and to alter the mix of music included in a play list and to alter the mix of music played from the playlist.

3. As per claims 2 & 13 Mackintosh disclosed wherein the current broadcast comprises a particular piece of music (col. 2, lines 50-54).

4. As per claims 3 & 14 Mackintosh disclosed wherein the deliverable information item associated with the broadcast comprises a compilation which includes the piece of music (col.2, lines 50-54).

5. As per claims 4 & 15 Cluts disclosed wherein the deliverable information item comprises a disk-based storage medium having the piece of music stored thereon (col. 7, lines 2-13).

6. As per claims 5 & 16 Cluts disclosed wherein the deliverable information item comprises a downloadable file containing the piece of music (col.3, lines 19-24 & lines 60-64).

7. As per claims 6 & 17 Cluts disclosed wherein the identification information comprises at least one of an artist, a title, an album name, a label identifier, a source identifier, a date, and a time associated with the current broadcast of the piece of music (col. 4, lines 46-51 & col. 15, lines 14-25).

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8. As per claims 7 & 18 Mackintosh disclosed wherein the identification information is extracted from a compressed digital audio bitstream associated with the current broadcast (col. 6, lines 5-15).

9. As per claims 8 & 19 Mackintosh disclosed wherein identification information is automatically extracted and stored for a plurality of distinct broadcasts upon entry of a corresponding user command (col. 5, lines 40-60).

10. As per claims 9 & 20 Mackintosh disclosed wherein the extracted identification information is stored in a memory of the wireless receiver which receives the current broadcast (col. 5, lines 39-60).

11. As per claims 10 & 21 Mackintosh disclosed wherein the extracted identification information is stored in a removable memory device associated with the wireless receiver which receives the wireless broadcast (col. 7, lines 2-13), and wherein the removable memory device is removable from the receiver and insertable into another device which establishes a network connection for delivery of the identification information to the server over the data network (col. 7, lines 14-27).

12. As per claims 11 & 22 Mackintosh disclosed wherein the extracted identification information is delivered to the server over a network connection established over the Internet (col. 9, lines 43-60).

Applicant's argument as follows:

13. Applicant amended the claims by adding the wireless technology as means of communication.

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Mackintosh disclosed the materials provided to the broadcast Internet service provider can include the actual radio broadcast from the radio station as well as event codes indicating current tracks in that broadcast, current advertising in that broadcast, or other data associated with the real time broadcast (col. 8, lines 41-50).

12. Applicant argued that prior art did not disclose in which identification information is extracted from a wireless broadcast in response to a user command entered at a wireless receiver, with the identification information being extracted and stored without requiring any connection between the wireless receiver and an access point of a data network.

As to applicant's argument the one ordinary skill in the art at the time of the invention has the knowledge that the information cannot be stored without being connected to the access point of a data network acting as a data transmitter. Even though considering that information can be stored without requiring any connection between the wireless receiver and an access point of a data network as Mackintosh disclosed when that track was initially played can be stores locally such that the information does not have to be re-retrieved when a history selection is made. Of course depending on the amount of the information retrieved and the storage space available, the number of selections for which material can be stored may vary. In one embodiment, the amount of information saved can be user selected (col. 16 lines 41-45). One ordinary skill in the art can interpret the storing locally as storing the product with out making any connection between the wireless receiver and an access point of a data network.

*Conclusion*

15. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (703)-305-4633.

16. The examiner can normally be reached on Monday to Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703)-308-5221. The fax for this group is (703)-746-7239.

17. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-746-7239 (For Status Inquiries, Informal or Draft Communications, please label "PROPOSED" or "DRAFT");

(703)-746-7239 (For Official Communications Intended for entry, please mark "EXPEDITED PROCEDURE"),

(703)-746-7238 (For After Final Communications).

18. Any Inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Any response to a final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks Washington, D.C.20231

Or faxed to:



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Hand-delivered responses should be brought to 4<sup>th</sup> Floor Receptionist, Crystal Park II,  
2021 Crystal Drive, Arlington, VA 22202.



Adnan Mirza

Examiner



**RUPAL DHARIA**  
**SUPERVISORY PATENT EXAMINER**